



Atty. Dkt. No. 355491-1253

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Christopher D. ROBERTS et al.

Title: NUCLEOSIDE DERIVATIVES
FOR TREATING HEPATITIS C
VIRUS INFECTION

Appl. No.: 10/821,638

Filing Date: 08 April 2004

Examiner: Lawrence E. Crane

Art Unit: 1623

Confirmation 9014
Number:

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RESPONSE TO STATEMENTS FOR REASONS FOR ALLOWANCE

Mail Stop Communication
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This communication is responsive to the Notice of Allowability dated April 7, 2006, concerning the above-referenced patent application. In the Statement for Reasons for Allowance, the Examiner stated that "[t]he reference submitted by applicant has been reviewed (Biota '757, PTO-1449 ref B6) and while it prospectively discloses some of the compounds herein, the exemplifications beginning at page 78 fail to enable any compounds wherein the C-7 position of a pyrrolo[2,3-d]pyrimidine nucleoside analogue is substituted by anything but hydrogen, a generic class of compounds not claimed herein."

For the sake of completion, Applicants note that Biota '757 does not disclose any of the compounds in the allowed claims. In the disclosed genera of compounds in Biota '757, there are many combinations of substituents such that the possible number of compounds is enormous.

Moreover, it is only by hindsight selection of appropriate substituents that compounds resembling those of the claimed can be constructed. In this regard, even in cases where a genus contains a small number of species, M.P.E.P. 2144.08 states that "[s]ome motivation is to select the claimed species or subgenus must be taught by the prior art." Biota '757 does not provide such motivation. Accordingly, the compounds in Biota '757 do not suggest the claimed invention nor prospectively disclose some of the compounds in the allowed claims.

Respectfully submitted,

Date 7-5-06

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